

## **RESPONSE**

### **In the Claims**

1. Claims 4-9, 11, 13-16, 18-26, 28-32, 34-48, 51, 52, 55-70 are pending in the Application.

2. Applicant expresses his appreciation for the allowance of claims 18-26, 28, 43, 47, and 48.

3. Claims 4-9, 11, 13-16, 29-32, 34-42, 44, 45, 51, 52, 55-60, and 64-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Int'l Pub. No. WO 98/03267 to Coffee ("Coffee"). The Examiner states that Coffee discloses processes and apparatus for forming material by electrohydrodynamic comminution capable of producing various solid and partially solid forms, such as fibers, etc., which forms may also contain a biologically active ingredient. The Examiner further states that "[c]laim limitations reciting specific moist tissue surfaces are considered by the examiner to be recitations of intended use, and thus do not carry patentable weight.

4. Applicant argues that statements of intended use do not, *per se*, lack patentable weight. In *In re Szajna*, the court noted that claim wording that "gives 'life and meaning' to [the claim]" is "more than a mere statement of intended use." 57 C.C.P.A. 899, 904, 422 F.2d 443, 447, 164 U.S.P.Q. 632, 636 (CCPA 1970) (preamble more than mere statement of intended use). *See, also, Rowe v. Dror*, 112 F.3d 473, 478, 42 U.S.P.Q.2d 1550 (Fed. Cir. 1997) ("The inquiry [into the effect given preamble recitations] involves examination of the entire patent record to determine what invention the patentee intended to define and protect."). In the instant case, the stated limitation is not in the preamble, but in the body of the claim. Thus, Applicant submits that claims 4-9, 11, 13-16, 29-32, 34-42, 44, 45, 51, 52 55-60, and 64-66, all of which include such limitation, distinguish patentably over Coffee which does not address such dissolution.

5. Applicant respectfully notes that claims 46 and 61-63 depend from currently allowed claims. As such, these claims are allowable and such action by the Examiner is respectfully requested.

6. Claims 67-70 are new. Support for these new claims is found throughout the Specification and entry by the Examiner is respectfully requested. Applicant submits that these claims distinguish patentably over the art of record and allowance by the Examiner is respectfully requested.

### Closure

1. Previously, fees were paid for a total of 54 claims and 4 independent claims. As submitted herewith, a total of 58 claims and 5 independent claims are remaining with the Application. Thus, additional claim-related fees under 37 C.F.R. § 1.16(i) of \$100.00 (4 claims \* \$25) and under 37 C.F.R. § 1.16(h) of \$100.00 (1 claim \* \$100) are due.


2. This is a request for a one-month extension of time to respond to the Office Action. A period for response was set to expire September 6, 2005. Thus, pursuant to 37 C.F.R. §§ 1.17(a)(1) and 1.27(a)(3) an extension-related fee of \$60.00 is due.

3. Applicant encloses herewith a credit card authorization form PTO-2038 for \$260.00 for the abovementioned fees. Please charge any additional fees, or credit any overpayments in connection with this Response to Applicant's undersigned counsel's Deposit Account 021266. A duplicate copy of this authorization is also enclosed.

4. The undersigned attorney for Applicant has made a good faith effort to meet the concerns expressed by the Examiner in the Office Action. If the Examiner still has some issues with the Application, and has any suggestions as to how to address them, the Examiner is invited to call the attorney for Applicant at the phone number below, so that those issues may be resolved.

5. Applicant submits that this Application is now in condition for further favorable consideration, culminating in allowance. Such action is respectfully requested.

Respectfully submitted,



William B. Richards, Esq.  
Reg. No. 44,301  
Attorney for Applicants

Battelle Memorial Institute  
505 King Avenue  
Columbus, OH 43201  
Phone: 614/424-5612  
Fax: 614/424-3864  
E-mail: [richardsw@battelle.org](mailto:richardsw@battelle.org)  
Customer Number: 24116